

REMARKS

In the Answer on appeal, the Examiner submitted a new ground of rejection based on the combination of previously cited Adam (U.S. Patent No. 840,892) and newly cited Nor (U.S. Patent No. 6,062,008). The Examiner repeated the rejection of Claims 18-20 as anticipated by Adam or, in the alternative, as obvious over Adam in view of Nor.

With respect to anticipation, the Examiner argues that Adam inherently teaches an elastic strap because most materials used for horse shoe straps are somewhat elastic, so that a user can pull or adjust the straps around horse hooves of various sizes (see page 3 of Answer). The applicant respectfully disagrees. A finding of inherency would require that the straps taught by Adams be necessarily elastic. There is no reason for such a finding, especially in view of the fact that Adams teaches the use of buckles with these straps, buckles that permit a user to do exactly what the Examiner deems necessary ("pull or adjust the straps...") without any elasticity being present in the straps.

Inasmuch as the applicant did not argue the separate allowability of Claim 20 over Claim 18 on appeal, he will not address the Examiner's argument that "different pieces of material" can be interpreted as "different cut pieces of material and not

necessarily as different materials "(see top of page 4 of the Answer). For the purposes of anticipation, the appellant will continue to rely instead only on Claim 18 as the basis for the allowability of both Claims 18 and 20.

To the extent that the Examiner seems to equate "elastic" to "flexible" (next sentence on top of page 4), it is respectfully submitted that the difference between the two is clear and should need no explanation. However, for the record, Merriam-Webster Dictionary defines "elastic," as an adjective (applicable to materials), as follows:

"-of a solid : capable of recovering size and shape after deformation; and
-capable of being easily stretched or expanded and resuming former shape."

Again with reference to materials, Merriam-Webster defines "flexible" as:

"-capable of being flexed."

Moreover, in listing synonyms for "elastic," Merriam-Webster describes "flexible" as follows:

"-Flexible applies to something which may or may not be resilient or elastic but which can be bent or folded without breaking."
(Emphasis added)

Thus, by dictionary definition, it is clear that any material that is elastic is also flexible, but the reverse is not necessarily true. Therefore, the dictionary definition of elastic does not provide support for an interpretation that the word "elastic" necessarily applies to all flexible materials.

With respect to obviousness, the Examiner rejected Claims 18-20 under 35 U.S.C. 103(a) as obvious over Adam in view of Nor. The applicant respectfully disagrees. Nor discloses an equine sock used to apply magnetic therapy to the hoof of a horse. The sock includes fastening straps 16 (see Fig. 1) that may be made of elastic webbing (see col. 2, lines 24-26). The Examiner found that the combination of the teachings of Adam and Nor renders obvious the invention of Claims 18-20.

When dealing with an obviousness rejection, it is well settled that to establish a *prima facie* case of obviousness there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Without a motivation to combine, the skill of the artisan, by itself, cannot be relied upon in hindsight to provide the suggestion to combine references. That is, the

teaching or suggestion to make the claimed combination must be found in the prior art, not in the applicant's disclosure. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. (MPEP §§ 2132, 2143)

Adam describes a horseshoe; that is, an article that serves the function of protecting the hoof of a horse under normal riding conditions, the same function performed by the applicant's boot. Horse boots are also used as alternatives to horseshoes. Nor's sock is not intended and in fact it could not be used as a riding article. Rather, it only serves the function of housing the therapeutic magnetic material that is at the heart of the Nor invention. As described, the Nor sock would not be suitable for any activity requiring protection of the hoof, including as an alternative to a horseshoe. The specific structure of the sock has no particular relevance to its function or to the present invention in the sense that any combination of sock components capable of covering the hoof would be equally acceptable to practice the Nor invention. The elastic straps used in the Nor sock teach that such straps can be used to secure a sock to the hoof of a horse in order to subject it to a magnetic field for therapeutic purposes.

Thus, understandably, because riding boots need to be tightly worn and securely strapped to the hoof of the horse, neither Adam nor Nor suggest using an elastic strap in a horse boot. Modifying the Adam boot by making the straps 8,9 elastic would produce an unsafe boot, likely to come off when subjected to the stresses of the horse putting weight on it while walking, trotting, or, worse, galloping. This has been a recurring problem that over the years has deterred the normal usage of horse boots in lieu of horseshoes, rather than just as protective wear in case of injury to the hoof. Therefore, one skilled in the art would have no motivation to modify the Adam boot to produce a boot fastened with elastic straps. In fact, four searches by the Examiner in this case, as old as the art is, have produced no horse boot with an elastic strap.

The present invention in fact does not consist of a boot with retaining elastic straps connected to a tongue entirely attached to the upper of the boot, as the combination of Adam and Nor would produce. Rather, it is a boot where the rear tongue extends from the wall circumscribing the rear of the hoof (not from the sole) and the elastic bands thus connect the tongue only to the upper portion of the wall. This distinction is relevant to understanding why Adam and Nor would not teach or suggest their combination to produce a tongue connected by elastic bands.

The existence of knowledge in the art (in this case, the fact that a strap may be made elastic) is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references (MPEP § 2143.01), and no such reason has been provided here.

Another requirement for a finding of *prima facie* obviousness is that there must be a reasonable expectation of success resulting from the combination. As mentioned, combining the teachings of Adam and Nor would produce a boot that could not be properly tied to the hoof of a horse. Because of the elasticity of straps 8,9 (the only means for securing the boot on the hoof), it is clear that the boot resulting from the combination would not be an improvement in the art. The art is rich in patents spanning over 100 years issued to inventors who introduced minor changes to horse boots in order to enhance performance, a large portion of them dedicated to improving tightness of fit and wearability, but none suggested that combination of teachings. Therefore, not only one skilled in the art would have no motivation to combine the teachings of these two references, but it is clear that their combination would not enjoy a reasonable expectation of success.

Finally, a *prima facie* case of obviousness requires that the combination of prior art references teach or suggest all the claim limitations. (See MPEP §§ 2132,2143.) Here, as mentioned above, the combination of Adam and Nor would teach a horse boot with a rear tongue extending upward from the sole, rather than from the wall supporting the rear of the hoof, as disclosed by the applicant (see Paragraphs 34-36 of the specification). Inasmuch as the elastic bands of the present invention do not serve a fastening purpose, this difference is what permits the boot to be functional.

The applicant has amended Claim 18 to recite these additional limitations and to include the two bands previously recited in Claim 19. It is noted that the amended language is entirely relevant to the new ground of rejection. In particular, the claim now recites a horse boot, rather than an article of footwear for a hooved animal, to distinguish Nor, which deals with a horse sock. The claim further recites a rear tongue that extends upward from the wall of the boot, rather than from the sole, in order to further distinguish the claimed invention from the combination of Adam and Nor. This distinction was not necessary to overcome anticipation by Adam alone.

In view of the foregoing, the appellant respectfully submits that Adam and Nor do not suggest their combination or modification to arrive at the present invention and no objective reason to combine or modify them exist. Their combination would not produce a boot with a reasonable probability of success and the resulting boot would not meet all limitations of Claim 18, as amended. Therefore, the basic requirements for a *prima facie* case of obviousness have not been met.

Accordingly, the applicant respectfully submits that Claims 18 and 20, as amended, are not anticipated by Adam and are not obvious over Adams in view of Nor.

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Respectfully submitted.



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